

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LEROY L. PETERSON

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Appeal No. 1999-0403  
Application 08/804,095<sup>1</sup>

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ON BRIEF

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Before STAAB, McQUADE and BAHR, Administrative Patent Judges.  
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 7-12, all the claims remaining in the application.

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<sup>1</sup> Application for patent filed February 20, 1997.

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Appellant's invention pertains to a protective cover for enclosing an inflatable swimming pool for improved strength, puncture resistance, and durability. Claim 7 is illustrative and reads as follows:

7. A protective cover for an inflatable swimming pool including a plurality of stacked inflatable rings including at least an upper inflatable ring and a lower inflatable ring and a floor extending across the bottom of the lower inflatable ring; wherein, the protective cover comprises:

a flexible enclosure including a top wall, a side wall and a bottom wall wherein said top wall and said bottom wall extend interiorly from said side wall and overlap at least a portion of the upper and lower inflatable rings respectively.

The following references are relied upon by the examiner in support of the rejections:

Lund	2,876,467	Mar. 10,
1959		
Hoenstine et al (Hoenstine)	4,451,239	May 29,
1984		
Reinhardt, Jr. et al (Reinhardt)	5,662,506	Sep. 2, 1997
		(filed Jun. 10,
1996)		
Hofmann <sup>2</sup>	928,274	May 26, 1955

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<sup>2</sup>Our understanding of this German language reference is derived from a translation prepared in the Patent and Trademark Office. A copy of the translation is attached to this opinion.

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(German)

The following rejections are before us for review:

a) claim 7, rejected under 35 U.S.C. § 102(b), as being anticipated by Hoenstine;

b) claims 7 and 11, rejected under 35 U.S.C. § 103, as being unpatentable over Lund in view of Reinhardt;

c) claims 8 and 12, rejected under 35 U.S.C. § 103, as being unpatentable over Lund in view of Reinhardt, and further in view of Hofmann; and

d) claims 9 and 10, rejected under 35 U.S.C. § 103, as being unpatentable over Lund in view of Reinhardt and Hofmann, and further in view of Hoenstine.

The rejections are explained in the examiner's answer (Paper No. 9, mailed July 23, 1998).

The opposing viewpoints of appellant are set forth in the brief (Paper No. 8, filed June 9, 1998).

As a preliminary matter, we note that appellant requests (brief, page 11) "a ruling from the Board of Appeals as to the rights of the applicant and/or the applicant's representative

to have a face-to-face personal interview with the Examiner. .  
. ." The matter complained of is clearly a matter within the  
examiner's discretion. In that we exercise no general

supervisory power over the examining corps,<sup>3</sup> we decline to  
consider the issue of whether the examiner abused his  
discretion in this matter. The relief sought by appellant  
would appear to have properly been presented by petition to  
the Commissioner under 37 CFR § 1.181.

*The anticipation rejection of claim 7*

*based on Hoenstine*

For reasons stated *infra* in our new ground of rejection,  
we are of the opinion that claim 7 and the claims that depend  
therefrom do not comply with the second paragraph of 35 U.S.C.  
§ 112. In general, when claims are indefinite, such that  
there must be considerable speculation as to the meaning of  
the terms in the claims, and assumptions as to their scope,

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<sup>3</sup> Compare *In re Mindick*, 371 F.2d 892, 894, 152 USPQ 566,  
568 (CCPA 1967) and *In re Deters*, 515 F.2d 1152, 1156, 185  
USPQ 644, 648 (CCPA 1975).

they should be rejected under 35 U.S.C. § 112, second paragraph, and not over the prior art. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). However, in the present case, in order to avoid piecemeal appellate review, we will interpret claim 7 as being directed to a protective cover *per se*, and proceed to consider the prior art rejections of claims 7-10 on that basis.<sup>4</sup> *Cf. Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. App. 1984).

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. *See RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), *cert. dismissed sub nom., Hazeltine Corp. v. RCA Corp.*, 468 U.S. 1228 (1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the

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<sup>4</sup> We appreciate that appellant urges a different interpretation of claim 7.

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reference, i.e., all limitations of the claim are found in the reference. See *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984), (*and overruled in part on another issue*) 775 F.2d 1107, 227 USPQ 577 (Fed. Cir. 1985).

Hoenstine discloses a hydroplane apparatus comprising a pneumatic vehicle innertube 11 with a flexible fabric cover 12 partly covering the innertube and forming a smooth bottom therefor. Central to the examiner's § 102 rejection of claim 7 is the examiner's determination that claim 7 is directed to a protective cover *per se*. The examiner contends that Hoenstine's cover 12 responds to the structural requirements of claim 7 in that Hoenstine's cover 12 includes a top wall (adjacent reinforced edge 21) overlying the top of the innertube, a side wall 13 overlying the outer periphery of the innertube, and a bottom wall (adjacent the outer edge portion of the cover's bottom 14) overlying the bottom of the innertube. The examiner further contends that Hoenstine's

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cover is capable of being used in the manner called for in claim 7. Thus, the examiner concludes that claim 7 "reads on" Hoenstine's cover 12.

The examiner's finding of facts and conclusions based thereon are well taken. The majority of appellant's arguments to the contrary are premised upon the view that claim 7 is directed to the combination of a protective cover and a swimming pool. However, in that we have interpreted claim 7 as being directed to

a cover *per se*, these arguments are not persuasive.

Appellant's additional argument that Hoenstine is directed to nonanalogous art is noted. The argument fails at the outset because the rejection is a § 102 anticipation rejection. *In re Self*, 671 F.2d 1344, 1350-51, 213 USPQ 1, 7 (CCPA 1982).

In light of the foregoing, we will sustain the § 102 rejection of claim 7 as being anticipated by Hoenstine.

*The obviousness rejection of claims 7 and 11*

*based on Lund and Reinhardt*

Lund comprises a collapsible raft comprising a pneumatic inflatable tube 11 with a flexible cover 13 of strong pliable sheet material partly covering the tube and forming a smooth bottom therefor. With reference to Figure 3, cover 13 includes a top wall (adjacent oarlock reinforcing plate 21) overlying the top of the innertube, a side wall 13b overlying the outer periphery of the innertube, and a bottom wall (adjacent reference numeral 13) overlying the bottom of the innertube. Further, the cover 13 of Lund reasonably appears to be fully capable of functioning in the manner called for in claim 7 when used with an appropriately sized inflatable swimming pool.

Viewed in this light, and bearing in mind that we have interpreted claim 7 as being directed to a protective cover *per se*, Lund provides response for all of the limitations of claim 7, making the teachings of Reinhardt mere surplusage in this rejection. While a rejection over a single reference such as Lund would ordinarily be based on 35 U.S.C. § 102



rather than 35 U.S.C. § 103, the practice of nominally basing rejections on § 103 when, in fact, the actual ground of rejection is that the claims are anticipated by the prior art has been sanctioned by a predecessor of our present review court in *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982) and *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). For these reasons, appellant's arguments of nonobviousness are simply not germane to the novelty issue discussed above. The standing § 103 rejection of claim 7 is therefore sustained.

Turning to claim 11, this claim differs from claim 7 in that it is clearly directed to the combination of a protective cover and a swimming pool. In rejecting this claim, the examiner acknowledges that Lund's inflatable article (i.e., tube 11) does not include plural rings and a floor. The examiner directs

attention to Reinhardt "which discloses an analogous inflatable article which includes plural rings 12, 14 and a

floor 18" (answer, page 5). Based on these teachings, the examiner concludes that "it would have been obvious . . . to associate<sup>[5]</sup> plural rings and a floor with the Lund inflatable article as being a conventional type of inflatable article" (answer, page 5).

Even if we were to agree with the examiner that, as a general proposition, it would have been obvious to replace the inflatable tube of Lund with a raft like that of Reinhardt to provide therein an inflatable member that comprises upper and lower inflatable rings and a floor, we do not consider that the subject matter of claim 11 would ensue. Claim 11 sets forth that the floor of the swimming pool "extend[s] across the bottom of the lower inflatable ring." In contrast, when it comes to a raft

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<sup>5</sup> In light of the examiner's statement on page 8 of the answer to the effect that he believes it would have been obvious to one of ordinary skill in the art to *substitute* one conventional raft for another in view of the teachings of the applied prior art, we consider the examiner's "association" of plural rings and a floor with Lund's inflatable article (answer, page 5) to involve *replacing* the inflatable tube 11 of Lund with an inflatable raft like that of Reinhardt.

comprising both an upper inflatable ring and a lower inflatable ring, Reinhardt unequivocally teaches that the floor 36 should extend *between* the rings at their interface (see Figures 1, 2, 8A, 8B and 8C). Accordingly, a fair consideration of the combined teachings of Lund and Reinhardt would not lead one of ordinary skill in the art to provide a "swimming pool" (i.e., inflatable raft) having a floor "extending across the bottom of the lower inflatable ring" in combination with the cover of Lund. In this regard, we appreciate that when Lund and Reinhardt are combined in the manner the examiner appears to propose, central portion 13a of Lund would, generally speaking, be located adjacent the bottom of the lower inflatable ring. However, Lund's central portion 13a would not undergo a metamorphosis from the floor of the cover into the floor of substituted inflatable raft in the proposed combination, especially when Reinhardt's raft already has a floor (i.e., element 36). To conclude otherwise would be an unreasonable interpretation of the reference teachings based on hindsight, in our view. For this reason, we will not sustain the standing § 103 rejection of claim 11.

*The obviousness rejection of claims 8 and 12*

*based on Lund, Reinhardt and Hofmann*

The examiner's reliance on the wooden or light metal rail elements (translation, page 2) of Hofmann for a teaching of providing reinforcing straps affixed to and extending between opposite sides of the bottom wall of cover of the modified Lund device is strained. As aptly noted by appellant on page 9 of the brief, the purpose of the rails in Hofmann is to tie together a pair of innertubes in side-by-side relationship, which purpose is simply not germane to Lund and/or Reinhardt. Absent appellant's own teachings, we can think of no cogent reason why one of ordinary skill in the art would have been motivated to incorporate Hofmann's rails in the Lund/Reinhardt combination. The § 103 rejection of claims 8 and 12 therefore will not be sustained.

*The obviousness rejection of claims 9 and 10*

*based on Lund, Reinhardt, Hofmann and Hoenstine*

The additional teachings of Hoenstine applied in this

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rejection do not render obvious what we have found to be lacking in the combined teaching of Lund, Reinhardt and Hofmann discussed

in the previous paragraph. The § 103 rejection of claims 9 and 10 will therefore not be sustained.

*New ground of rejection pursuant to 37 CFR § 1.196(b)*

Pursuant to 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 7-10 are rejected under 35 U.S.C. § 112, second paragraph, as being of indeterminate scope for the reason discussed below.

The preamble of claim 7 states that the claim is directed to a protective cover "for an inflatable swimming pool." A fair reading of this language is that the claim is directed to a protective cover *per se* with the "for an inflatable swimming pool . . ." language of the preamble being a statement of environment or intended use. In contrast, the body of the claim states that the protective cover comprises a top wall

and a bottom wall that "overlap at least a portion of the upper and lower inflatable rings respectively." Thus, the body of the claim positively incorporates the swimming pool into the claimed subject matter by positively reciting the structural relationship between the top and bottom walls of the cover and the upper and lower rings of the swimming pool. If one gives full effect to the language of

the preamble, the claim must be considered to be directed to the protective cover *per se*. On the other hand, if one gives full effect to the language appearing in the body of the claim, the claim must be considered to be directed to the combination of the cover and swimming pool. This inconsistency makes the scope of claims 7-10 unclear.

*Summary*

The rejection of claim 7 as being anticipated by Hoenstine is affirmed.

The rejection of claims 7 and 11 as being unpatentable over Lund in view of Reinhardt is affirmed with respect to claim 7, but is reversed as to claim 11.

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The rejection of claims 8 and 12 as being unpatentable over Lund in view of Reinhardt and Hofmann, and the rejection of claims 9 and 10 as being unpatentable over Lund in view of Reinhardt, Hofmann and Hoenstine are reversed.

In addition, a new rejection of claims 7-10 under 35 U.S.C. § 112, second paragraph, pursuant to 37 CFR § 1.196(b) has been made.

The decision of the examiner is affirmed-in-part. In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the

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original decision . . . .

37 CFR § 1.196(b) also provides that the appellant,  
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise  
one of the following two options with respect to the new  
ground of rejection to avoid termination of proceedings (37  
CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the  
claims so rejected or a showing of facts relating to  
the claims so rejected, or both, and have the matter  
reconsidered by the examiner, in which event the  
application will be remanded to the examiner. . . .

(2) Request that the application be reheard  
under § 1.197(b) by the Board of Patent Appeals and  
Interferences upon the same record. . . .

Should the appellant elect to prosecute further before  
the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in  
order to preserve the right to seek review under 35 U.S.C. §§  
141 or 145 with respect to the affirmed rejection, the  
effective date of the affirmance is deferred until conclusion  
of the prosecution before the examiner unless, as a mere  
incident to the limited prosecution, the affirmed rejection is



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overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

*AFFIRMED-IN-PART; 37 CFR § 1.196(b)*

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LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
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